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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Ryan et al.

Appl. No. 09/667,720

Filed: September 22, 2000

For: RF Active Compositions for Use in  
Adhesion, Bonding and Coating

Confirmation No. 9377

Art Unit: 1771

Examiner: Salvatore, L.

Atty. Docket: 2113.0040004/RWE/ALS

#6  
P. Qua  
8/5/02

### Reply To Restriction Requirement

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Commissioner for Patents  
Washington, D.C. 20231

Sir:

In reply to the Office Action dated **July 1, 2002**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-20 and 25-28. Consonant with this requirement, Applicants also elect the acrylic acid copolymer species, upon which claims 1-5, 9, 14-20 and 25-28 read thereon. Applicants also note that in addition to claims 1-5, 18, 25, 26 and 29 (identified by the Examiner as generic), claims 14-17, 19, 20, 27 and 28 are generic. *See* PTO File Wrapper Paper No. 5, p. 5. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

#### *Traversal of the Restriction Requirement*

This election is made **with** traverse. Two criteria must be satisfied in order to establish a *prima facie* showing that a restriction requirement is proper: (1) the inventions must be independent or distinct as claimed; *and* (2) the Examiner must face a serious burden if restriction is not required. MPEP § 803 (emphasis added). It should be noted that these two requirements set forth in MPEP § 803 are in the conjunctive. Hence, satisfaction of

both criteria is required. Applicants respectfully assert that the Examiner has not satisfied both of these criteria and hence, has not set forth a *prima facie* showing of a proper restriction requirement.

With respect to the first criteria, the Examiner asserts that Groups I and II are independent inventions as they "are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product . . . and the species are patentably distinct . . . In the instant case, the intermediate product is deemed to be useful as a component in any one of the multiple product inventions claimed above and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants." See PTO File Wrapper Paper No. 5, p. 3. However, the Examiner provides no explanation or description of the alleged intermediate-final product relationship. The restriction requirement does not indicate which Group(s) (or claims) correspond to an intermediate product, or which Group(s) (or claims) correspond to a final product. It is unclear to Applicants how Groups I and II possess an intermediate-final product relationship as described by M.P.E.P. § 806.04(b). In contrast with the relationship suggested by the Examiner, Applicants respectfully point out that the claims of Group II provide additional structural limitations to the compositions of claims 1 and 18 of Group I. Such additional limitations do not create an intermediate-final product relationship between Groups I and II. Hence, the Examiner has not satisfied the first criteria for a proper restriction requirement as it relates to Groups I and II.

With respect to the second criteria, Applicants respectfully point out to the Examiner that Groups I and II are closely related in subject matter. In particular, all of the claims of

Group II depend from claims 1 or 18 of Group I, and as such, a search of one group of claims is likely to encompass subject matter pertinent to the patentability of both groups. Moreover, the M.P.E.P. indicates that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. Hence, Applicants respectfully assert that the Examiner has not set forth the second criteria for a *prima facie* showing that a restriction requirement is proper.

Reconsideration and withdrawal of the Restriction Requirement as it applies to all of the claim groups is respectfully requested. In the alternative, Applicants respectfully request that Groups I and II be examined together.

***Traversal of Election of Species Requirement***

Applicants respectfully remind the Examiner that a reasonable number of species may be claimed in different claims in a single application, provided the application includes a claim generic to all the claimed species and the claims drawn to alleged species are dependent from the generic claim(s). See 37 C.F.R. § 1.141(a). Moreover, when inventions are (a) species under a claimed genus and (b) related, then the question of whether or not an election of species requirement is proper must be addressed using the criteria for determining whether or not a restriction requirement is proper; if restriction is improper under the facts of the case, an election of species requirement should not be made. See MPEP § 806.04(b).

In the present case, the alleged species identified by the Examiner in paragraph 4 of the Restriction Requirement (see PTO File Wrapper Paper No. 5, p. 4) are all related (each being an ionomer) and they all ultimately depend from claim 1 which has been identified by

the Examiner as being generic. *See Id.* p. 5. Therefore, both requirements under 37 C.F.R. § 1.141(a) are met, and it must be determined whether or not restriction would be proper in the present case to determine the propriety of the election of species requirement.

As noted above, the criteria for a proper restriction are that (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803. Applicants respectfully assert that the Examiner has not satisfied both criteria. The species identified by the Examiner in paragraph 4 of the Restriction Requirement are all dependent on claim 1 and hence, represent closely related subject matter. As such, a search of one of these alleged species is likely to encompass subject matter pertinent to the patentability of all members, particularly since the points of novelty of each member lies primarily in claim 1 from which the species claims depend. Moreover, the Examiner has not shown by appropriate explanation any of the three reasons supporting a serious burden if restriction were not required, as set forth in MPEP § 808.02. A serious burden therefore has not been established, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803.

Since a restriction requirement would not be proper under the facts of the present case, Applicants respectfully assert that the Election of Species requirement is improper as well under 37 C.F.R. § 1.141 and MPEP 806.04(b). Therefore, reconsideration and withdrawal of the Election of Species requirement is respectfully requested.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions

of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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July 31, 2002

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Commissioner for Patents  
Washington, D.C. 20231

Art Unit 1771

Re: U.S. Utility Patent Application  
Appl. No. 09/667,720; Filed: September 22, 2000  
For: **RF Active Compositions for Use in Adhesion, Bonding and Coating**  
Inventors: Ryan *et al.*  
Our Ref: 2113.0040004/RWE/ALS

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply to Restriction Requirement; and
2. Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Aaron L. Schwartz  
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